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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,353	01/31/2001	Neil R.N. Enns	13768.178.1	4025

22913 7590 12/05/2003

WORKMAN NYDEGGER (F/K/A WORKMAN NYDEGGER &  
SEELEY)

60 EAST SOUTH TEMPLE  
1000 EAGLE GATE TOWER  
SALT LAKE CITY, UT 84111

EXAMINER
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HASHEM, LISA

ART UNIT	PAPER NUMBER
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2645

4

DATE MAILED: 12/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/773,353

Applicant(s)

ENNS ET AL.

Examiner

Lisa Hashem

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-33 are pending in this office action.

***Drawings***

2. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on January 31, 2001 have been accepted.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4, 8, 10-11, 16-20, 23, 25-28, and 32 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S. Patent No. 6,636,733 by Helferich.

Regarding claims 1, Helferich discloses in a computerized system that includes one or more mobile devices (Figure 1, 10) and an electronic message server (Figure 1, 16) supporting wireless communication (see Figure 1), wherein at least some of the mobile devices have an input system that is inherently optimized for numeric input rather than text input (column 2, lines 34-38), and wherein at least some of the mobile devices are capable of sending and receiving electronic messages (column 8, lines 6-9), a method of composing an electronic message using a mobile device, the method comprising the acts of: receiving a command to begin inherently composing an electronic message; receiving a command to add audio content to the electronic message (column 8, lines 19-21); diverting to a

temporary storage or temporary mailbox, an audio content stream received at an audio input (column 4, lines 48-62); inherently storing the audio content stream in a format that is compatible with adding audio content to the electronic message; and attaching the formatted audio content to the electronic message (column 6, lines 64 – column 7, line 1; column 8, lines 13-16 and lines 21-24).

Regarding claim 2, a method as recited in claim 1, wherein Helferich further discloses the mobile device comprises a phone (as shown in Figure 1, 10) and the temporary storage inherently comprises a temporary data file (column 4, lines 54-56), and wherein the audio content stream received at the audio input is generated by a user inherently speaking into the phone's mouthpiece (column 4, lines 61-62).

Regarding claim 3, a method as recited in claim 1, wherein Helferich further discloses the electronic message comprises an electronic mail message (column 8, lines 6-9), and wherein the formatted audio content is attached as an electronic mail attachment (column 6, lines 64 – column 7, line 1; column 8, lines 13-16 and lines 21-24).

Regarding claim 4, a method as recited in claim 3, wherein Helferich further discloses the electronic mail message is composed in either replying to or forwarding a specific electronic mail message (column 8, lines 21-26), the method further comprising the act of receiving the specific electronic mail message (column 5, lines 42-45).

Regarding claim 8, a method as recited in claim 1, wherein Helferich further discloses receiving the command to add audio content to the electronic message is based on either the selection of a user interface menu item to add audio content to the electronic message or the press of a record button (column 8, lines 21-22).

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Regarding claim 10, Helferich discloses in a computerized system that includes one or more mobile devices (Figure 1, 10) and an electronic message server (Figure 1, 16) supporting wireless communication (see Figure 1), wherein at least some of the mobile devices have an input system that is inherently optimized for numeric input rather than text input (column 2, lines 34-38), and wherein at least some of the mobile devices are capable of sending and receiving electronic messages (column 8, lines 6-9), a method of composing an electronic mail message using a mobile device, the method comprising the acts of: receiving a command to begin inherently composing an electronic mail message; receiving a command to add audio content to the electronic mail message (column 8, lines 19-21); diverting to a temporary storage or temporary mailbox, an audio content stream received at an audio input (column 4, lines 48-62); inherently storing the audio content stream in a format that is compatible with adding audio content to the electronic mail message; and attaching the formatted audio content to the electronic mail message (column 6, lines 64 – column 7, line 1; column 8, lines 13-16 and lines 21-24).

Regarding claim 11, please see the rejection of the method in claim 4 to reject the method in claim 11.

Regarding claim 16, Helferich discloses in a computerized system that includes one or more mobile devices (Figure 1, 10) and an electronic message server (Figure 1, 16) supporting wireless communication (see Figure 1), wherein at least some of the mobile devices have an input system that is inherently optimized for numeric input rather than text input (column 2, lines 34-38), and wherein at least some of the mobile devices are capable of sending

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and receiving electronic messages (column 8, lines 6-9), a method of composing an electronic message using a mobile device, the method comprising the acts of:

initiating the creation of an electronic message, the electronic message to include audio content; capturing audio content from an audio content stream being received at an audio input, wherein the audio content stream is generated by a user inherently speaking into the audio input; adding the audio content to the electronic message in a format that is inherently compatible with the electronic message (column 6, lines 64 – column 7, line 1; column 8, lines 13-16 and lines 21-24).

Regarding claim 17, a method as recited in claim 16, wherein Helferich further discloses the mobile device comprises a telephone (as shown in Figure 1, 10), and wherein the audio stream is generated by a user inherently speaking into the telephone's mouthpiece (column 4, lines 61-62).

Regarding claim 18, A method as recited in claim 16, wherein the electronic message comprises an electronic mail message, and wherein the step for adding the audio content to the electronic message comprises the acts of inherently formatting the captured audio content stream to be compatible with the electronic mail message; and attaching the formatted audio content to the electronic mail message (column 6, lines 64 – column 7, line 1; column 8, lines 21-24).

Regarding claim 19, a method as recited in claim 18, wherein Helferich further discloses the electronic mail message is composed in either replying to or forwarding a specific electronic mail message (column 8, lines 21-26), and wherein the step for initiating the creation of the electronic mail message includes the act of receiving the specific electronic mail message (column 5, lines 42-45).

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Regarding claim 20, a method as recited in claim 16, wherein Helferich further discloses the step for capturing audio content from the audio content stream comprises the acts of diverting the audio content stream to a temporary storage; and storing the audio content stream in the temporary storage (column 4, lines 48-62).

Regarding claim 23, a method as recited in claim 16, wherein Helferich further discloses the step for initiating the creation of an electronic message comprises the acts of receiving a command to begin inherently composing an electronic message; and receiving a command to add audio content to the electronic message, wherein the act of receiving the command to add audio content to the electronic message is based on either the selection of a user interface menu item to add audio content to the electronic message or the press of a record button (column 8, lines 21-24).

Regarding claim 25, Helferich discloses in a computerized system that includes one or more mobile devices (Figure 1, 10) and an electronic message server (Figure 1, 16) supporting wireless communication (see Figure 1), wherein at least some of the mobile devices have an input system that is inherently optimized for numeric input rather than text input (column 2, lines 34-38), and wherein at least some of the mobile devices are capable of sending and receiving electronic messages (column 8, lines 6-9), a computer program product for implementing a method of composing an electronic message using a mobile device, comprising: a computer readable medium or message processor for carrying machine-executable instructions for implementing the method (Figure 1, 18); and wherein said method is inherently comprised of machine-executable instructions for a mobile device performing the acts of:

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receiving a command to begin inherently composing an electronic message; receiving a command to add audio content to the electronic message (column 8, lines 19-21); diverting to a temporary storage or temporary mailbox, an audio content stream received at an audio input (column 4, lines 48-62); inherently storing the audio content stream in a format that is compatible with adding audio content to the electronic message; and attaching the formatted audio content to the electronic message (column 6, lines 64 – column 7, line 1; column 8, lines 13-16 and lines 21-24).

Regarding claim 26, a computer program product as recited in claim 25, wherein Helferich further discloses the mobile device comprises a phone (as shown in Figure 1, 10) and the temporary storage inherently comprises a temporary data file (column 4, lines 54-56), and wherein the audio content stream received at the audio input is generated by a user inherently speaking into the phone's mouthpiece (column 4, lines 61-62).

Regarding claim 27, a computer program product as recited in claim 25, wherein Helferich further discloses the electronic message comprises an electronic mail message (column 8, lines 6-9), and wherein the formatted audio content is attached as an electronic mail attachment (column 6, lines 64 – column 7, line 1; column 8, lines 13-16 and lines 21-24).

Regarding claim 28, a computer program product as recited in claim 27, wherein Helferich further discloses the electronic mail message is composed in either replying to or forwarding a specific electronic mail message (column 8, lines 21-26), the method further comprising the act of receiving the specific electronic mail message (column 5, lines 42-45).

Regarding claim 32, computer program product as recited in claim 25, wherein Helferich further discloses receiving the command to add audio content to the electronic message is based



on either the selection of a user interface menu item to add audio content to the electronic message or the press of a record button (column 8, lines 21-22).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5, 14, 21, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,636,733 by Helferich in view of U.S. Patent No. 6,421,707 by Miller et al, hereinafter Miller.

Regarding claim 5, 14, 21, and 29, wherein Helferich fails to disclose: the total amount of audio content that may be stored in temporary storage is limited to a predetermined maximum, the method further comprising the act of displaying a progress indicator to show a current amount of temporary storage used in storing the data stream compared to the predetermined maximum.

Helferich teaches a memory management arrangement for automatically deleting messages stored in a mobile phone when the device's memory is full (column 8, lines 47-50). When the memory becomes full, one or more message bodies are overwritten, to make room for a new message to be stored (column 8, line 65 – column 9, line 2).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Helferich to include a memory management arrangement for the temporary storage as taught by Helferich to limit the temporary storage to a predetermined

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maximum. One of ordinary skill in the art would have been lead to make such a modification since the message processor functions as a voice store and forward system and needs a limit to store voice messages for the user, in order for new messages to be stored and old messages to be deleted.

Miller discloses a wireless multimedia messaging communications method and apparatus that permits a subscriber to a wireless communications service to receive and generate multimedia messages from known wireless personal communications devices (see Abstract). In a computerized system that includes one or more devices (Figure 3, 301) and an electronic message server or WDS (wireless data server) (Figure 3, 320; column 2, lines 46-51) supporting wireless communication (see Figure 3), wherein at least some of the devices have an input system that is inherently optimized for numeric input rather than text input (e.g. by dialing a phone number), and wherein at least some of the devices are capable of sending and receiving electronic messages (Figure 1, 151). In opening an email message, Miller further discloses displaying the size of an email that is received at said device (as shown in Figure 4m, Entire Mail (73K)) in comparison to the predetermined maximum size of the user's Inbox (Figure 4c, 700KB), wherein notification is sent to the user when the mailbox size exceeds the quota limit.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Helferich to include displaying the size of the current amount of storage used in storing the email compared to the predetermined maximum as taught by Miller to make sure the user does not exceed the quota limit. One of ordinary skill in the art would have been lead to make such a modification since a sender should make sure the predetermined

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maximum of a storage area for files has not been reached, in order for attachments to be sent successfully.

7. Claims 6-7, 9, 12-13, 15, 22, 24, 30-31, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,636,733 by Helferich in view of U.S. Patent No. 6,421,707 by Miller et al, hereinafter Miller.

Regarding claims 6-7, 9, 12-13, 15, 22, 24, 30-31, and 33, wherein Helferich fails to disclose: (a) wherein the format used to store the audio content stream allows for data compression, the method further comprising the act of compressing the audio content stream in accordance with the storage format; (b) wherein the storage format is a WAV file format; (c) displaying an indicator that audio content has been attached to the electronic message; and displaying the size of the attached audio content; and (d) wherein attaching the formatted audio content to the electronic mail message complies with a Multipurpose Internet Mail Extensions (MIME) specification.

Miller discloses a wireless multimedia messaging communications method and apparatus that permits a subscriber to a wireless communications service to receive and generate multimedia messages from known wireless personal communications devices (see Abstract). In a computerized system that includes one or more devices (Figure 3, 301) and an electronic message server or WDS (wireless data server) (Figure 3, 320; column 2, lines 46-51) supporting wireless communication (see Figure 3), wherein at least some of the devices have an input system that is inherently optimized for numeric input rather than text input (e.g. by dialing a phone number), and wherein at least some of the devices are capable of sending and receiving electronic messages (Figure 1, 151). Miller further discloses receiving an email on said device

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(Figure 4h), an indicator that indicates an audio content is attached to the email, and a display of the size of the attached audio content (Figure 4s, Wav (3K)). The audio content is a WAV file, which inherently allows for data compression. The attached WAV file inherently complies with a MIME specification.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Helferich to include an audio content in WAV file format that complies with a MIME specification, an indicator that indicates an audio content is attached to the email, and a display of the size of the attached audio content as taught by Miller to send an email with a voice attachment. One of ordinary skill in the art would have been lead to make such a modification since the user of the mobile device that is composing the email message can see the indicator on said device to make sure that the audio content is attached and see the display of the audio attachment. Also, the attachment will be compressed because it is in WAV file format and the attachment complies with a MIME specification.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- U.S. Patent Application Publication by Kinnunen et al teach a cellular radiotelephone where a user can send a sound file as an attachment in an email; wherein an indicator displays the sound file is attached in said email

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9. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**Or faxed to:**

(703) 872-9314 (for formal communications intended for entry)

**Or call:**

(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to: Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (703) 305-4302. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

LH

lh

November 28, 2003

FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

